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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,289	01/02/2004	Syed F.A. Hossainy	50623.363	2385

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Cameron K. Kerrigan
Squire, Sanders & Dempsey L.L.P.
Suite 300
1 Maritime Plaza
San Francisco, CA 94111

EXAMINER

HAGOPIAN, CASEY SHEA

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/751,289

Applicant(s)

HOSSAINY ET AL.

Examiner

Casey Hagopian

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-64 is/are pending in the application.
- 4a) Of the above claim(s) 38-40 and 42-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37, 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Receipt is acknowledged of applicant's Response to Restriction Requirement filed 4/28/2005.

Election/Restrictions

2. Applicant's election with traverse of Group II (claim 41) in the reply filed on 4/28/2005 is acknowledged. The traversal is on the ground(s) that applicants do not believe that examining additional claims 38-40 and 42-63 would impose an undue hardship on the examiner. This is not found persuasive because as the applicants point out that these claims are drawn to an implantable device or in some instance more specifically a stent, the applicants fail to appreciate that the different inventions do not have in common various elements including different materials used in the primer and reservoir regions, the inclusion or lack thereof a chromium oxide layer, different surface/substrate materials, etc. Each of the inventions has different issues regarding patentability and enablement, and art anticipating one group would not necessarily anticipate or render obvious another group. Each invention requires different searches in both patent and non-patent databases, and there is no expectation that the searches would be coextensive. As such, this does impose an undue hardship on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

3. Claim 41 is objected to because of the following informalities: the term "polyester diacrylates" appears twice on line 2 in the Markush group of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 41 is rejected under 35 U.S.C. 102(b) as being anticipated by Ragheb et al. (USPN 5,824,049).

6. Ragheb discloses a coated implantable medical device comprising a primer layer, a drug layer, and a porous layer, wherein the primer layer is posited onto the surface of the medical device (abstract; figure 1; column 11, lines 1-5). It should be noted that the examiner is interpreting the drug layer and porous layer together as a reservoir region. The instant claim only defines the reservoir region as comprising a drug and the instant specification states, "a coating having a reservoir region carrying an active agent" (page 5, line 19) and "the primer and reservoir regions can be made from the same polymeric material or different polymeric materials" (page 5, line 25 – page 6, line1). It is unclear how the drug and polymer interact within the reservoir

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region. Regheb also discloses polymers including photopolymerizable polyethylenically unsaturated acrylic esters containing two or more acrylate groups per molecule such as trimethylopropane triacrylate (column 11, lines 21-39). Therefore, the disclosures of Ragheb render the claim anticipated.

Conclusion

7. The elected claim 41 has been rejected; no claims are allowed.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Casey Hagopian whose telephone number is 571-272-6097. The examiner can normally be reached on M-F from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carlos Azpuru, can be reached at 571-272-0588. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Casey Hagopian

Casey (Rosenthal) Hagopian
Examiner
Art Unit 1615

Carlos A. Azpur
CARLOS A. AZPUR
PRIMARY EXAMINER
GROUP 1500